

This Opinion is Not a
Precedent of the TTAB

Mailed: September 27, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Herve US, LLC

Serial No. 88703522

Serial No. 88703545
—

Sirina Tsai, Derek A. Newman, and Jessica V. Newman of Newman Du Wors LLP
for Herve US, LLC.

Kerry A. Nicholson, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.
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Before Wellington, Pologeorgis and English,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Herve US, LLC (“Applicant”) seeks registration on the Principal Register of the standard character marks HERVE and HERVÉ, both for “bakery goods and bakery desserts for wholesale distribution” (as amended) in International Class 30.¹

The Examining Attorney has refused registration of both marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion

¹ Application Serial Nos. 88703522 and 88703545, respectively; each filed November 22, 2019 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) based on Applicant’s allegation of a bona fide intent to use the mark in commerce.

with the standard character mark HERVÉ for “restaurant and bar services” in International Class 43.² When the refusals were made final, Applicant appealed. The appeals are fully briefed.

We reverse the refusals to register.

I. Separate Appeals, Single Opinion

These two appeals involve common issues of law and fact. Accordingly, we issue a single opinion for both. *In re Consumer Protection Firm PLLC*, 2021 USPQ2d 238, at *3 (TTAB 2021). Each proceeding, however, retains its separate character. A separate judgment will be entered for each application and a copy of this decision shall be placed in each proceeding file. *Id.*

The evidentiary records in the appeals are identical. We refer to the record in application Serial No. 88703522.³

II. Evidentiary Record

In its appeal briefs, Applicant references (but did not attach) searches of the Trademark Electronic Search System (TESS) for “live applications or registrations [in Class 43] that include ‘restaurant’ or ‘bar’ in the description of goods and services,” “live applications and registrations [in Class 30] that include the word ‘wholesale’ as well as either ‘baked’ or ‘dessert’ in the description of goods and services” and

² Registration No. 5586351; registered October 16, 2018.

³ All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. *See, e.g., In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 n.4 (TTAB 2018). References to the briefs on appeal refer to the Board’s TTABVUE docket system. Before the TTABVUE designation is the docket entry number and after this designation are the page references.

“applications or registrations that appear in both searches.”⁴ The Examining Attorney has objected on the ground that “[n]one of the referenced information [was] included during prosecution[.]”⁵

Applicant argues that the “objection is misplaced” because “any applicant seeking to advance a statistical argument would have to submit tens of thousands of third-party registrations into the record – an absurd result that would not benefit the examiner, the applicant, the Board, or the public at large.”⁶ Applicant further asserts that it “does not seek to make any third-party registration part of the record. Rather Applicant is simply making a statistical observation derived from the Trademark Office’s own compilation and categorization of those registrations. This is precisely the kind of fact that may be judicially noticed under Rule 201 of the Federal Rules of Evidence[.]”⁷

Pursuant to Trademark Rule 2.142(d), “[t]he record in the application should be complete prior to the filing of the appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.” 37 C.F.R. § 2.142(d). If Applicant wished to rely on the referenced search results, it should have made them of record during prosecution.⁸ The Board’s well-established practice is not to take judicial notice of its

⁴ Appeal Brief, 4 TTABVUE 8-9.

⁵ Examining Attorney’s Brief, 6 TTABVUE 3-4.

⁶ Reply Brief, 7 TTABVUE 3.

⁷ *Id.* at 3-4.

⁸ Alternatively, Applicant could have submitted the declaration of the person who conducted the searches attesting to the search results.

own records (or statistics purportedly derived from such records). *See, e.g., In re Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998) (denying request in reply brief that Board take judicial notice of “thousands of registered marks incorporating the term NEW YORK for products and services that do not originate in New York state or city”), *aff’d*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.04 (2021) (explaining that “the Board’s judicial notice practice ... is designed to encourage applicants (and examining attorneys) to fully raise their arguments during prosecution, where they can be more efficiently resolved, and to avoid unnecessary or inefficient appeals.”). Taking judicial notice here would be particularly problematic because the Board would have to recreate Applicant’s purported searches. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69955 (Oct. 7, 2016) (“The official record of a Board proceeding must be complete, accurate, and reliable, especially because in direct appeals to the Federal Circuit the court’s review of the Board’s decision is confined to the four corners of the administrative record. ... The burden of creating a complete evidentiary record by introducing in documentary form information contained in the USPTO’s trademark file records is most appropriately borne by the party wishing to introduce such evidence rather than by the Board.”).

Accordingly, the Examining Attorney’s objection is sustained. We have not considered Applicant’s argument based on the referenced TESS search results.

With respect to the Internet articles and article excerpts Applicant submitted with its September 3, 2020 Office action response, we note that this evidence does not bear the required URL addresses and dates the material was accessed and printed. *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018). The Examining Attorney, however, did not raise any objection to the evidence or explain to Applicant how to properly introduce such material. Accordingly, any objection to Applicant's Internet evidence is deemed waived or forfeited. *Id.*; *see also In re Mueller Sports Meds., Inc.*, 126 USPQ2d 1584, 1586 (TTAB 2018) (objection may be deemed waived if examining attorney fails to object and advise applicant of the proper way to make Internet evidence of record). We have considered the evidence.

III. Analysis

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*") cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co. Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is argument and evidence. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc'ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) ("While we

have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). In a particular case, a single *DuPont* factor may be dispositive. *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991).

A. Similarity of the Marks

Under the first *DuPont* factor, we consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. Appx. 516 (Fed. Cir. 2019).

The issue is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression such that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 688 F.3d 1356, 1011 USPQ2d 1713, 1721 (Fed. Cir. 2012). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *Geigy Chem. Corp. v. Atlas Chem. Indus.*,

Inc., 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

There is no dispute that the mark HERVÉ in application Serial No. 88703545 is identical to the cited mark HERVÉ.

The mark in application Serial No. 88703545, HERVE, differs from the cited mark only in the absence of an acute accent over the last letter “É.” Applicant argues that this is a sufficient distinction because the accent “serves to give the [cited mark] a somewhat European connotation” and consumers familiar with French are likely to pronounce the cited mark as “air-vay” while Applicant’s HERVE mark may be pronounced “in more varied ways” with or without a silent “h” and with or without a long “a.”⁹

Consumers with a hazy recollection, and without the benefit of a side-by-side comparison, may not notice or remember the accent in the last letter of the cited mark. *Conwood Corp. v S.A. Bongrain-Gerard*, 190 USPQ 155, 158 (TTAB 1976) (“[T]he average member of the American purchasing public would not normally be aware of the significance of the accent mark appearing over the letter ‘E’ of applicant’s mark, and hence would not be apt to place too much significance or reliance on this feature of the mark as a recognition factor.”); *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and

⁹ Appeal Brief, 4 TTABVUE 11-12.

remembered[.]”); *cf. In re Champion Int’l Corp.*, 196 USPQ 48, 49 (TTAB 1977) (holding that no distinction can be drawn between CHECK MATE with or without a hyphen between the words).

Consumers who do notice this minor difference are likely to perceive the mark HERVÉ as a French word or given name. Because Applicant’s mark is not an English word it may create the same or similar commercial impression. We think it is likely that the marks will also be pronounced similarly. To this end, Applicant’s mark starts with the same first three letters as the English word “herb,” which is pronounced with a silent “h,” so consumers may be inclined to pronounce the mark HERVE similarly to the French pronunciation of HERVÉ. “There is no correct pronunciation of a trademark that is not a recognized word.” *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012) (“[T]here is no correct pronunciation of a trademark, and consumers may pronounce a mark differently than intended by the brand owner.”).

For all of these reasons, we find that the first *DuPont* factor weighs heavily in favor of a likelihood of confusion with respect to both of Applicant’s marks.

B. Similarity of the Goods and Services

Under the second *DuPont* factor we consider “[t]he similarity or dissimilarity and nature of the goods or services.” *DuPont*, 177 USPQ at 567; *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018). We must base our comparison of the goods on the identifications in the cited registration and

Applicant's applications. See *Stone Lion Capital*, 110 USPQ2d at 1162; *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). "It is well settled that goods and services need not be similar or competitive in nature to support a finding of likelihood of confusion." *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). The evidence need only establish that the goods and services are related in some manner, or the conditions surrounding their marketing are such that they would likely be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *Opus One*, 60 USPQ2d 1812, 1814-15 (TTAB 2001); see also *Coach Servs.*, 101 USPQ2d at 1721.

The Examining Attorney asserts that where, as here, the marks are identical and nearly identical, "the degree of similarity or relatedness between the goods and services needed to support a finding of likelihood of confusion declines."¹⁰ Nevertheless, the relationship between Applicant's goods and Registrant's services, "must consist of 'something more' than the fact that [applicant] uses the mark on a food or beverage item ... and [registrant] uses the mark in connection with restaurant services." *Opus One*, 60 USPQ2d at 1815; See also *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003); *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2030 (Fed. Cir. 1993); *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982); *In re Giovanni*

¹⁰ Examining Attorney's Brief, 6 TTABVUE 7.

Food, 97 USPQ2d at 1991-92; *In re Azteca Rest. Enters. Inc.*, 50 USPQ2d 1209, 1210-11 (TTAB 1999).

To show that the goods and services are related and demonstrate the requisite “something more,” the Examining Attorney introduced screenshots from third-party websites purporting to show 9 entities using the same mark for bakery goods and/or bakery desserts sold to wholesale consumers and restaurant services:¹¹

- PANERA BREAD;
- KRISPY KREME DOUGHNUTS;
- GRAND CENTRAL Bakery & Café;
- ALPINE BAKERY & TRATTORIA (restaurant) and ALPINE BAKERS, INC. (wholesale division);
- BALTHAZAR (restaurant) and BALTHAZAR BAKER (wholesale division);
- CECI CELA PATISSERIE;
- COLSON PATISSERIE;
- PAIN D’AVIGNON Restaurant & Boulangerie; and
- PANÉ RUSTICA Restaurant & Bakery.

The Examining Attorney asserts that this evidence “clearly shows that the goods and services at issue are related because restaurants frequently specialize in and market their bakery goods and dessert items for wholesale distribution[.]”¹² Applicant

¹¹ March 3, 2020 Office Action, TSDR 7-21; October 3, 2020 Final Office Action, TSDR 6-33.

¹² Examining Attorney’s Brief, 6 TTABVUE 8. The screenshots from PANERA BREAD and KRISPY KREME do not expressly state that the goods are sold to wholesale consumers but Applicant has not disputed the Examining Attorney’s characterization of the evidence.

criticizes the evidence arguing that: (1) the Examining Attorney “has not [shown] ‘something more’ than just nine companies offering restaurant and wholesale baked goods”; (2) “[t]he Examining Attorney cites no evidence showing what influence those nine relationships may have on consumer perception”; and (3) “the crossover between nine restaurants and wholesale baked goods [does not] demonstrate anything about either the ubiquity or rarity of such businesses.”¹³

We do not need evidence to know that there are a “very large number of restaurants in this country,” *Coors Brewing*, 68 USPQ2d at 1064, and that the food offerings are varied. Each of the 9 restaurants identified above are retail bakeries or specialize in or feature bakery products. Evidence that some retail bakeries or restaurants that specialize in bakery goods also sell bakery goods and desserts to wholesale consumers is not particularly persuasive as to whether restaurant services **in general** are related to bakery goods and desserts sold to wholesale consumers. *In re Giovanni Food*, 97 USPQ2d at 1991 (“The mere fact that some restaurants that specialize in barbeque also provide catering services and sell barbeque sauce is not

The Examining Attorney asserts that the Trademark Act “also protects against ‘reverse confusion’.... In this case, assuming arguendo that the goods are sold in different channels of trade, consumers may perceive applicant as the source of the retail goods featured in registrant’s restaurants.” Examining Attorney’s Brief, 6 TTABVUE 10. There is, however, no evidence in the record to support that Applicant is a significantly larger or prominent junior user. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (“The term ‘reverse confusion’ has been used to describe the situation where a significantly larger or prominent newcomer ‘saturates the market’ with a trademark that is confusingly similar to that of a smaller, senior registrant for related goods or services.”) (citations omitted). Indeed, Applicant filed its applications based on an intent to use the marks so there is no evidence at all of Applicant’s use. Nor is there evidence that Applicant is a significant player in the restaurant market.

¹³ Appeal Brief, 4 TTABVUE 8.

sufficient to establish a relationship between catering services *in general* and barbeque sauce.”). Moreover, there is no evidence that Registrant’s restaurant specializes in bakery goods. *Id.*; *cf. Azteca*, 50 USPQ2d at 1211 (“Applicant’s mark itself makes it clear that its restaurant serves Mexican food, and a review of applicant’s menu shows that applicant serves a variety of Mexican fare, including tacos, tortillas and salsa (that is, the very items listed in the cited registrations.)”); *Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074, 1705 (TTAB 1990) (“Since PANCAKE HOUSE denotes the fare to be served in the restaurant, it would be logical to assume that a GOLDEN GRIDDLE syrup would have the same service as a GOLDEN GRIDDLE PANCAKE HOUSE.”).

Applicant submitted a few articles discussing strategies for retailers to expand into the wholesale business.¹⁴ One of those articles was specific to the food industry and it addressed expanding from “a retail bakery business [to] providing bulk products at wholesale prices....”¹⁵ This evidence suggests that consumer businesses generally might offer goods and services to both retail and wholesale markets and that this might be a profitable business strategy for bakeries. But one article suggesting that some retail bakeries – a subset of Registrant’s broadly described “restaurant services” – market bakery goods wholesale and the nine third-party

¹⁴ September 3, 2020 Office Action Response, TSDR 8-71.

¹⁵ *Id.* at 33-36. Applicant submitted the articles to support that there are “differences in marketing to retail versus wholesale consumers,” *id.* at 5, but evidence of record may support a position other than the one it was submitted to support. Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a) (“When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.”).

examples the Examining Attorney submitted are not sufficient to establish a viable commercial relationship between restaurant services generally and bakery goods and desserts sold to wholesale consumers.

Accordingly, we find that the evidence fails to satisfy the “something more” requirement. *Cf. Opus One*, 60 USPQ2d at 1815-16. The second *DuPont* factor, therefore, does not favor finding a likelihood of confusion.

C. Similarity of the Trade Channels and Classes of Consumers and the Sophistication of the Purchasers

The third *DuPont* factor concerns “[t]he similarity or dissimilarity of established, likely-to-continue trade channels,” while the fourth *DuPont* factor concerns “[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. Applicant argues that the overlap in customers would be *de minimis*, comprised only of restaurant patrons who are also wholesale bakery customers, and that this group of customers has “sophisticated knowledge about the sources of food” and “are well-qualified to distinguish between restaurants and wholesale bakery companies” because they are “professionally involved in the supply chain for restaurants and other retail outlets.”¹⁶ We agree.

On the record before us, there would be little or no opportunity for most restaurant patrons to be confused. 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:51 (5th ed. March 2021 update) (where one entity sells

¹⁶ Appeal Brief, 4 TTABVUE 9-10.

exclusively at retail to the general public and the other sells exclusively to wholesale consumers, there may be little likelihood of confusion if the wholesale product does not reach the retail consumer under the mark). Bakery goods generally are not the types of products that would commonly be served to restaurant patrons in packaging or in another way that would expose restaurant patrons to the wholesaler's mark (e.g. as would condiments or wine). *Cf. Opus One*, 60 USPQ2d at 1815 (finding wine and restaurant services related, in part, because restaurant patrons are exposed to both the restaurant's mark and the marks for wine, which appear on restaurant wine lists and the wine bottles served to patrons). While the evidence suggests that the bakery goods of the restaurant PANERA BREAD and bakery KRISPY KREME might ultimately reach the end-user consumer through food retailers, two examples are not sufficient to demonstrate that it is common for bakery goods sold wholesale to reach the end-user consumer under the wholesaler's mark such that we can presume that that would be the case with Applicant's goods. *See In re Albert Trostel*, 29 USPQ2d 1783, 1786 (TTAB 1993) ("What is missing from the record is convincing evidence that finished products of this nature [luggage, attaché cases, portfolio briefcases, and handbags] commonly carry not only the trademark of their manufacturer but also the trademark of the producer of the leather from which they are made" such that "the ultimate purchasers of registrant's goods are likely to encounter applicant's mark as well as registrant's."); *Cf. In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988) ("[W]e are of the opinion that customers of registrant's restaurant who encounter applicant's 'MUCKY DUCK' and design mustard in the grocery store or

supermarket are likely to believe that the mustard originates with or is in some way associated with registrant, that is, that the restaurant is selling its own ‘special’ mustard through retail outlets.”); *In re Revillon*, 154 USPQ 494, 495 (TTAB 1967) (“whether sold at retail or at wholesale, the goods of the parties reach the ultimate purchasers bearing their respective trademarks.”).

The only consumer group common to both Applicant and Registrant are restaurant patrons who are also wholesale bakery customers. This is an extremely narrow group of common purchasers, and we agree with Applicant that such consumers are likely to be sophisticated and to exercise a greater level of care when purchasing food items whether in their professional or personal capacity. *Electronic Design & Sales v. Electronic Data Sys.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) (“[A]ny overlap in customers is too small to be significant much less dispositive” and “in any event [the potential or actual purchasers] are sophisticated enough that the likelihood of confusion remains remote.”). Buyer expertise does not always eliminate a likelihood of confusion, especially when the marks are identical or nearly identical, but here, the sophistication of the small segment of common purchasers is significant. *Id.*

Accordingly, the third and fourth *DuPont* factors do not weigh in favor of finding a likelihood of confusion.

IV. Conclusion

Although Applicant’s marks are identical and nearly identical to the cited mark, the current record does not support a finding that Applicant’s “bakery goods and

bakery desserts for wholesale consumers” are commercially related to Registrant’s “restaurant services.” There is very little overlap in the respective consumers and the small segment of common consumers are likely to be sophisticated and exercise a high degree of care in purchasing the respective goods and services. Accordingly, based on the record before us, we conclude that the potential for consumer confusion is a mere possibility, not a probability. *Electronic Design & Sales*, 21 USPQ2d at 1393; *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1402, 164 USPQ 43, 44-45 (CCPA 1969) (“We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.”).

Decision: The refusals to register Applicant’s marks under Section 2(d) of the Trademark Act are reversed.